

EXPRESS MAIL LABEL NO. EL417645598US

PATENT REISSUE APPLICATION

Docket No. 11527.209

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No.: 5,662,731 )  
Issued: September 2, 1997 )  
Inventors: Per Just Andersen, Ph.D., et al. ) Art Unit  
Assignee: E. Khashoggi Industries, LLC ) 1314  
For: BIOLOGICALLY DEGRADABLE )  
POLYMER MIXTURE )  
Examiner: Blaine Copenheaver )

DECLARATION IN SUPPORT OF REISSUE APPLICATION

1. I, JOHN M. GUYNN, Registration No. 36,153, am attorney of record for the inventors named in previously filed U.S. application Serial No. 08/327,524, filed October 21, 1994, which issued as U.S. Patent No. 5,662,731 on September 2, 1997, for which an application for reissue is sought. The original Power of Attorney is still in force. In addition, I represent the Assignee of record, E. Khashoggi Industries, LLC, whose ownership rights of U.S. Patent No. 5,662,731 are evidenced by the assignments recorded at reel 7371, frame 813 (original assignment from inventors to E. Khashoggi Industries) and reel 8761, frame 333 (subsequent assignment from E. Khashoggi Industries to E. Khashoggi Industries, LLC).

2. The named inventors of U.S. Patent No. 5,662,731 (hereinafter "Inventors"), as established by declarations previously filed during prosecution of said U.S. application Serial No.

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08/327,524, are PER JUST ANDERSEN, Ph.D., and SIMON K. HODSON, citizens of the Kingdom of Denmark and the United States of America, respectively, whose residences and post office addresses are 947 Via Fruteria, Santa Barbara, California 93110 and 4621 Via Roblada, Santa Barbara, California, 93110, respectively. Inventors, by said previously filed declarations, believed themselves to be the original, first, and joint inventors of the subject matter of the invention or discovery set forth in said U.S. application Serial No. 08/327,524, which issued as said U.S. Patent No. 5,662,731. On information and belief, the undersigned attorney believes this to be true. The Inventors and Assignee together constitute the "Applicants" for this application for reissue.

3. Inventors, by a Supplemental Declaration filed April 23, 1997, declared that they had reviewed and understood the content of the specification, including the claims, as amended in Preliminary Amendment "A" filed December 9, 1994, Amendment "B" and Response filed March 18, 1996, Amendment "C" and Response filed October 3, 1996, an Examiner's Amendment mailed January 15, 1997, and a Rule 312 Amendment filed January 29, 1997. On information and belief, the undersigned attorney believes this to be true. In addition, the undersigned attorney has reviewed and understands the content of the specification, including the claims, as amended in the aforementioned amendments.

4. Applicants, by and through the undersigned attorney, acknowledge the ongoing duty to disclose information which is material to the examination of this reissue application in accordance with Section 1.56(a) of Title 37 of the Code of Federal Regulations.

5. Applicants, by and through the undersigned attorney, believe that U.S. Patent No. 5,662,731 is wholly or partly inoperative by reason of Applicants having claimed less than the Applicants had the right to claim in the patent.

6. Applicants, by and through the undersigned attorney, when initially drafting and filing the claims, and during subsequent amendments, sought to protect what they considered to be their invention by claiming the aqueous compositions used to manufacture the finished articles of manufacture. In particular, Applicants sought protection for aqueous starch-based compositions used in the manufacture of finished starch-bound articles of manufacture exemplified by issued claim 1, which reads as follows:

1. A starch-based composition for molding into an article having a starch-bound cellular matrix, the starch-based composition comprising water, a starch-based binder in a concentration greater than about 20% by weight of the starch-based composition, and a fibrous material having an average fiber length greater than about 2 mm and an aspect ratio greater than about 10:1, wherein the fibers are substantially homogeneously dispersed throughout the starch-based composition, wherein the starch-based binder includes a substantially ungelatinized component comprising unmodified starch granules in an amount in a range from about 50% to about 90% by weight of the starch-based binder and a substantially gelatinized component comprising gelatinized starch in an amount in a range from about 10% to about 50% by weight of the starch-based binder prior to molding the composition into the article.

7. It was originally believed that the foregoing claim, as well as the other composition claims that issued as part of U.S. Patent No. 5,662,731, adequately protected the invention for which patent protection was sought. During the course of prosecution Applicants relied on the limitations found in the claims to define over the prior art, including U.S. Patent No. 4,613,627 to *Sherman et al.* and WO 91/02186 to *Tiefenbacher et al.* Such limitations were unique to the aqueous compositions being claimed and were found to distinguish over the prior art. The limitations in the issued claims were believed at the time to be the best way to distinguish over the prior art of record.

8. Subsequent to the issuance of U.S. Patent No. 5,662,731, Applicants began considering whether to use certain coating materials, which are disclosed but not claimed in U.S.

Patent No. 5,662,731, on the outer surface of finished articles manufactured according to U.S. Patent No. 5,662,731. Since the claims that issued in U.S. Patent No. 5,662,731 are directed to the aqueous compositions used to manufacture the finished articles of manufacture, rather than to the finished articles themselves, the claims, by default, did not provide any mechanism for claiming a coating on finished articles made using the compositions. Moreover, Applicants did not fully appreciate the inventive nature of the coatings themselves when used to coat starch-bound articles of manufacture according to the disclosure of U.S. Patent No. 5,662,731. Only after the issuance of U.S. Patent No. 5,662,731 did Applicants come to realize that claims directed to the combination of the specific coating materials with the starch-bound articles would provide better protection than merely claiming the aqueous compositions used to manufacture the starch-bound articles, which themselves are coated by the specific coating materials.

9. If, during the prosecution of said U.S. Patent No. 5,662,731, more particularly, if during the pendency of said U.S. application Serial No. 08/327,524, Applicants had more fully understood the inventiveness of the coatings themselves when used in combination with molded starch-bound articles, Applicants would have considered filing for protection of this invention, either in substitution for the composition claims that eventually issued, or in a continuation application that could have only been filed while said U.S. application Serial No. 08/327,524 was still pending.

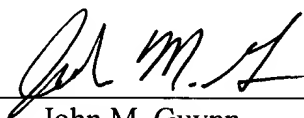
10. In reviewing U.S. application Serial No. 08/327,524 for purposes of filing the present reissue application, the undersigned attorney noticed an error in the continuing data at the beginning of the patent that apparently arose in the printing of the patent. Although such error may also be corrected by means of a Certificate of Correction, it seems appropriate to correct this error at this time for economy and efficiency. In particular, the continuing data section of the printed patent fails to include the following statement, which is the last sentence in the "Related Applications" section

of the originally filed application (page 3, lines 22-24), which was never cancelled or deleted at any time by Applicants: --For purposes of disclosure of the present invention, each of the foregoing applications is incorporated herein by specific reference.--

10. Applicants, by and through the undersigned attorney, do declare that the foregoing errors being corrected in the present reissue application arose without any deceptive intention on the part of Applicants or the undersigned attorney.

11. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the reissue application or any patent issuing thereon.

Signed at Salt Lake City, Utah, this 2<sup>nd</sup> day of September 1999.



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Registration No. 36,153  
Attorney of Record for Applicants

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**U.S. DEPARTMENT OF JUSTICE**

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No. 43,020; R. PARRISH FREEMAN, JR., Registration No. 42,556; ADRIAN J. LEE, Registration No. 42,785; and KYLE H. FLINDT, Registration No. 42,539, who are members of Workman, Nydegger & Seeley, as associate attorney for me in the above-entitled application. Please address all future written and telephonic communications to:

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Dated this 2<sup>nd</sup> day of September, 1999.

Respectfully submitted,



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